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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,432	04/06/2001	Gabriel Vogeli	00145.US1	6178

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EXAMINER

ULM. JOHN D

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 10/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/828,432	Applicant(s) VOGELI ET AL.	
	Examiner John D. Ulm	Art Unit 1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) 22-24,30-71 and 73-82 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 25-29 72 83-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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1) Claims 1 to 88 are pending in the instant application. Claims 1, 3, 25, 27 and 72 have been amended and claims 83 to 88 have been added as requested by Applicant in the correspondence of 20 August of 2003.

2) Claims 22 to 24, 30 to 71 and 73 to 82 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 14.

3) Any objection or rejection of record which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

4) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5) Claims 1 to 21, 25 to 29, 72 and 83 to 88 are rejected under 35 U.S.C. § 101 because they are drawn to an invention with no apparent or disclosed specific and substantial credible utility for those reasons of record as applied to claims 1 to 21, 25 to 29 and 72 in section 4 of Paper Number 15.

Applicant has traversed this rejection on the premise that a polypeptide of the instant invention has a specific utility in the identification of ligands thereto. This is not persuasive because, as stated in the original rejection, "whereas one could readily employ a putative receptor protein encoded by the claimed nucleic acid in an assay to identify ligands thereto the information

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obtained thereby would be of little use until one discovers the identity of those physiological processes moderated by that putative receptor”.

Applicant has further traversed this rejection on the premise that a protein encoded by the claimed polynucleotide can be employed as a tissue marker for brain, lymph node, testis and pituitary, and the employment of that protein as a tissue marker is a credible, specific and substantial utility. The employment of a protein of the instant invention, or a nucleic acid encoding that protein, as a tissue specific marker is not a substantial or specific utility. All human proteins can invariably be classified into two categories, those which are expressed in a tissue or developmentally specific manner and those which are expressed ubiquitously. It can be alleged that any protein which is expressed in a tissue specific manner can be employed to detect the tissue in which it is expressed in a sample. Alternately, a human protein which is expressed ubiquitously can be employed to detect the presence of any human tissue in a sample. Such utilities are analogous to the assertion that a particular protein can be employed as a molecular weight marker, which is neither a specific or substantial utility.

One could just as readily argue that any purified compound having a known structure could be employed as an analytical standard in such processes as nuclear magnetic resonance (NMR), infrared spectroscopy (IR), and mass spectroscopy as well as in polyacrylamide gel electrophoresis (PAGE), high performance liquid chromatography (HPLC) and gas chromatography. None of these processes could be practiced without either calibration standards having known molecular structures or, at least, a range of molecular weight markers having

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known molecular weights. One could further extrapolate upon this premise by asserting that any item having a fixed measurable parameter can be employed to calibrate any machine or process which measures that parameter. For example, any item having a constant mass within an acceptable range can be employed to calibrate a produce scale in a grocery store. The calibration of produce scales is certainly an important function since most states require produce scales to be calibrated and certified. Therefore, to accept Applicant's arguments that any nucleic acid encoding any protein of human origin is useful as a marker would be comparable to conceding that any object of fixed mass has *prima facie* utility as a weight standard, irrespective of any other properties possessed by that object. It was just such applications that the court appeared to be referring to when it expressed the opinion that all chemical compounds are "useful" to the chemical arts when this term is given its broadest interpretation (*Brenner v. Manson*, 148 U.S.P.Q. 689 (Sus. Ct, 1966)). Because the steroid compound which was the subject of that decision had a known structure and molecular weight it could have readily been employed as a molecular standard at that time. Further, because that compound was a hydrocarbon it certainly could have been employed in the well known process of combustion for purposes of lighting and/or the generation of heat. The generation of heat by combustion of hydrocarbons certainly was and remains an important process. Irrespective of such obvious utilities, the court still held that the compound produced by the process at issue in *Brenner v. Manson* did not have a specific and substantial utility.

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To grant Applicant a patent encompassing an isolated polynucleotide encoding a naturally occurring human protein of as yet undetermined biological significance, or the protein encoded thereby, would be to grant Applicant a monopoly “the metes and bounds” of which “are not capable of precise delineation”. That monopoly “may engross a vast, unknown, and perhaps unknowable area” and “confer power to block off whole areas of scientific development, without compensating benefit to the public” (*Brenner v. Manson, Ibid*). To grant Applicant a patent on the claimed polynucleotide based solely upon an assertion that the protein encoded thereby can be employed as a tissue marker is clearly prohibited by this judicial precedent since the compensation to the public is not commensurate with the monopoly granted and would be no different than granting a patent on the process disputed in *Brenner v. Manson* on the premise that the steroid produced thereby was useful as an analytical standard or as a combustible fuel source.

Applicant has also traversed this rejection on the apparent premise that membership in the G protein-coupled receptor family is, alone, sufficient to establish a utility for a specific protein and, therefore, the claimed assay. Applicant asserts that a protein of the instant invention belongs to a family of proteins of which some members are the targets of “nearly” 350 therapeutic agents currently on the market. This number is actually higher since a number of agents such as antidepressants and hypertension medications were being employed clinically before their site of action was known. However, each clinical agent which has been developed by measuring its interaction with a specific G protein-coupled receptor was evaluated against a receptor whose native ligand and physiological function were known, such as the adrenergic receptors, the

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dopamine receptors and the serotonin receptors. There are also numerous G protein-coupled receptors such as odorant receptors and calcium sensing receptors which do not appear to mediate any clinically significant process. More importantly, an artisan knew, before they employed a specific G protein-coupled receptor to identify clinically useful compounds, which physiological process or processes they wished to manipulate and that the protein employed in their assay had an influence of that process. Even if one identifies an agonist or antagonist for a receptor of the instant invention by employing the claimed method, this information is useless since one has no idea of what clinical effect the administration of that agonist or antagonist to an individual would have.

Applicant's reference to issued patents describing G protein-coupled receptors as establishing a patentable utility for the claimed nucleic acid is not persuasive because each application is examined on its own merits. In the decision of *In re Hutchison*, 69 USPQ 138 (CCPA, 1946), the court held that

"We are not concerned, of course, with the allowed claims in either the patent or in this application. The sole question for our determination is whether the six article claims on appeal were properly rejected below, and this we pass upon without further reference to, and without comparing them with, the claims in the patent or the claims which stand allowed in this application."

In essence, the position in the instant application that each application is examined on its own merits can be found in the judicial precedent cited above. The rejections in the instant application will only be withdrawn if they are shown to be legally or factually unsound. The fact that a patent

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may have issued under a different fact situation or in error does not relieve the USPTO from the responsibility of preventing the reoccurrence of such errors wherever possible.

6) Claims 1 to 21, 25 to 29, 72 and 83 to 88 are rejected under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to use the instant invention for those reasons given above with regard to the rejection of these claims under 35 U.S.C. § 101.

7) Claims 72, 83 and 86 to 88 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7.1) Claims 72 and 86 to 88 are vague and indefinite because the limitation “stringent hybridization conditions” is conditional and neither the claims nor the instant specification identifies a single set of conditions that define this limitation. The description of this limitation on page 10 of the instant specification is vague because it employs qualifying terms such as “typically” and “generally”.

7.2) Claim 72 is confusing in the recitation of the phrase “a polynucleotide encoding comprising the amino acid sequence ...”.

7.3) Claim 83 is confusing in so far as it refers to “a sequence of SEQ ID NO:1” because there only appears to be one sequence in SEQ ID NO:1. Therefore, this claim should probably refer to “the sequence of SEQ ID NO:1”.

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8) Applicant's arguments filed 20 August of 2003. have been fully considered but they are not persuasive.

9) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10) This application contains claims 22 to 24, 30 to 71 and 73 to 82, drawn to an invention nonelected with traverse in Paper No. 14. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

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Official papers filed by fax should be directed to (703) 308-4242 or (703) 872-9306.
Official responses under 37 C.F.R. § 1.116 should be directed to (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to be "John D. M.", written over a rectangular stamp.

JOHN D. M.
PRINCIPAL
GROUP 1